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No. 08-446

In the Supreme Court of the United States

ARISTOCRAT TECHNOLOGIES AUSTRALIA PTY LIMITED AND ARISTOCRAT TECHNOLOGIES, INC.,
Petitioners,

v.

INTERNATIONAL GAME TECHNOLOGY AND IGT,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENTS IN OPPOSITION

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QUESTION PRESENTED

Whether the Federal Circuit correctly held that petitioners' means-plus-function patent claim violates the rule against functional claiming and is invalid for indefiniteness where the only structure disclosed in the specification is a computerized gaming machine with "appropriate" programming.

RULE 29.6 STATEMENT

Respondent International Game Technology has no parent corporation, and no publicly held company owns 10 percent or more of its stock. Respondent IGT is a wholly owned subsidiary of International Game Technology.

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BRIEF FOR RESPONDENTS IN OPPOSITION

STATEMENT

The petition does not raise a certworthy issue. In addition to the "vehicle" problems set forth below, the panel decision was a unanimous and straightforward application of the established rule against functional claiming. There was no dissent from denial of rehearing, and there is no "disarray" in the Federal Circuit's decisions in this area (Pet. 24), which consistently apply the same established principles to particular patents in particular factual contexts. Applying those principles to petitioners' patent, the court properly found that petitioners impermissibly seek a patent monopoly over any computerized slot machine that performs the recited functions, no matter how they are performed. The patent laws forbid such broad functional claiming, which would stifle invention to the detriment of the public, as this Court has frequently recognized.

The Patent Act permits an element in a claim for a combination to be expressed as a means to perform a specified function without describing the underlying structure. 35 U.S.C. § 112, ¶ 6. However, there is a *quid pro quo* for this statutory dispensation. In return, the applicant's patent specification must disclose the structure that constitutes the means. "If the specification is not clear as to the structure that the patentee intends to correspond to the claimed function, then the patentee has not paid the price but is rather attempting to claim in functional terms unbounded by any reference to structure in the specification." *Biomedino, LLC* v. *Waters Techs. Corp.*, 490 F.3d 946, 948 (Fed. Cir.) (citing cases), cert. denied, 128 S. Ct. 653 (2007). Failure to disclose the required

structure renders a claim indefinite, and a claim that is indefinite violates the Patent Act requirement that a patent must particularly point out and distinctly claim the invention, rendering it invalid. *Id.* at 949, citing 35 U.S.C. § 112, ¶ 2.

The Federal Circuit unanimously ruled that petitioners' patent fails to comply with these established principles. Their slot machine patent claims a "control means" to perform certain functions, such as paying a prize when a player selects a predetermined combination of symbols. The only structure disclosed in the specification for that control means is a "standard microprocessor-based gaming machine by means of appropriate programming," which the court held does not satisfy the structure requirement.

The court explained that "[t]he term 'appropriate programming' simply references a computer that is programmed so that it performs the function in question, which is to say that the function is performed by a computer that is capable of performing the function." Pet. App. 12a. Such "pure functional claiming" does not comply with the requirements of the Patent Act. *Id.* at 19a.

To prevent such overbroad claiming, the court explained, "[i]n cases involving a computer-implemented invention in which the inventor has invoked means-plus-function claiming, this court has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor." Pet. App. 9a-10a. The rationale is that "general purpose computers can be programmed to perform very different tasks in very different ways." *Id.* at 10a. Thus, "simply disclosing a computer as the structure designated to perform a particular function does not limit the scope

of the claim to 'the corresponding structure, material, or acts' that perform the function, as required by section 112 paragraph 6." *Ibid.*

Instead, the court explained, the specification must disclose an algorithm, which need not be highly detailed or mathematically complex, that transforms the general purpose computer into a "special purpose" computer designed to perform the functions recited in the claim. Pet. App. 11a, 22a. The court concluded that petitioners' mere disclosure of a computerized gaming machine with "appropriate programming" fails to satisfy that non-stringent requirement. *Ibid.*

As demonstrated below, the Federal Circuit conventionally applied these established principles to petitioners' patent and found it wanting. The court held petitioners to the same standard of disclosure it requires of all patentees who claim in means-plus-function fashion. This case thus raises no issue warranting the Court's review.

REASONS FOR DENYING THE PETITION

I. The Petition Has "Vehicle" Defects.

The validity of the '102 patent is likely a moot issue. Petitioners filed a reissue application in May 2008, canceling all twelve claims of the '102 patent and adding thirteen new claims, none of which is a means-plus-function claim. Petitioners' designee submitted a declaration therewith stating, under penalty of perjury: "I verily believe the original patent to be wholly or partly inoperative or invalid * * * by reason of the patentee claiming more or less than he had the right to claim in the patent" and "by reason of other errors." App., *infra*, 1a. Citing one such error, petitioners declared: "The means-plus-function

limitations of claim 1 were determined by the Court of Appeals for the Federal Circuit to lack sufficient structure under 35 U.S.C. § 112, ¶ 6, and therefore held to be indefinite under 35 U.S.C. § 112, ¶ 2." *Id.* at 2a. In short, petitioners have renounced the very claim on which their petition is based. And even if the petition is not technically moot (because petitioners' reissue application has not yet been granted), petitioners' declaration appears to waive any continuing validity of the '102 patent.

Petitioners have waived review in other ways as well. The petition's primary argument is that an algorithm is not structure for purposes of a "product" claim but rather a "series of acts" for purposes of a "process" claim. Pet. 16-17. Petitioners did not make that argument below, where they never distinguished between a "product" and a "process" claim. See *TRW Inc.* v. *Andrews*, 534 U.S. 19, 34 (2001) (issue waived "because it was not raised or briefed below"); *Sprietsma* v. *Mercury Marine*, 537 U.S. 51, 56 n.4 (2002). What is more, petitioners' current contention that "an 'algorithm' is not 'structure'" (Pet. 16) is directly contrary to what they did argue below. In the court of appeals, petitioners argued that the '215 patent specification "provides an adequate disclosure of 'structure,'" including "several algorithms." Pet. C.A. Br. 35. Petitioners should not be permitted to reverse course in this Court.

Finally, the petition is a poor vehicle because, even if it were granted and the Court ruled for petitioners, the '215 patent would remain invalid. As the petition notes, in addition to finding a lack of structure, the district court found the patent indefinite on an alternative ground, namely, that the patent does not "link" any structure to the asserted functions.

See Pet. 9 n.1, citing Pet. App. 35a-37a. The Federal Circuit did not disturb that alternative holding, and the petition does not challenge its propriety. Thus, reversal of the Federal Circuit's ruling on the structure disclosure issue would leave the alternative ground for invalidity in place, a further reason why the question presented is not certworthy.

II. The Decision Below Routinely Applied Settled Law.

There is nothing novel about the decision below. It is simply a straightforward application of the settled rule against functional claiming. It also is entirely consistent with the precedents of this Court, the Federal Circuit, and district courts that have addressed this issue.

A. The decision below applied the established rule against functional claiming.

It has long been the law that "a patentee may not broaden his claims by describing the product in terms of function." *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228, 234, 236 (1942) (rejecting claim where the patent specification was "almost entirely in terms of function"); accord *General Elec. Co.* v. *Wabash Appliance Corp.*, 304 U.S. 364, 371 (1938); see also *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (a patent claim may cover a machine "but never the function"); *Westinghouse* v. *Boyden Power Brake Co.*, 170 U.S. 537, 562 (1898) ("the function of a machine cannot be patented"). If one could obtain a patent merely by disclosing the function, that would discourage the invention of better means to perform the function and thereby harm the public.

To avoid that harm, this Court long has rejected any "functional claim" that describes the purported invention "in terms of what it will do rather than in terms of its own physical characteristics or its arrangement." *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U.S. 1, 9, 12 (1946). As the Court explained: "In this age of technological development there may be many other devices beyond our present information or indeed our imagination which will perform that function and yet fit these claims." *Id.* at 12. The Court warned that allowing "broad functional claims" would discourage "inventive genius" from developing novel "devices to accomplish the same purpose." *Ibid.*

To be sure, when Congress enacted the 1952 Patent Act, it expressly authorized means-plus-function claims (and thereby overruled *Halliburton*). But to avoid the risks of functional claiming, Congress expressly required that the patent specification disclose sufficient structure. As the Federal Circuit recently explained, "[t]his statutory provision was meant to preclude the overbreadth inherent in open-ended functional claims, such as those [which] effectively purport to cover any and all means so long as they perform the recited functions." *Halliburton Energy Servs., Inc.* v. *M-I LLC*, 514 F.3d 1244, 1256 n.7 (Fed. Cir. 2008).

Such an overbroad claim is precisely what petitioners seek to validate and enforce in this case. They filed a means-plus-function claim that discloses only functions and unspecified "means" to perform them. The specification then discloses only a computerized gaming machine with "appropriate" programming as the purported structure. Today, of course, all gaming machines are computerized, and

adding "appropriate" programming says only that the computerized gaming machine will perform the recited functions. As the Federal Circuit explained, petitioners' "reference to 'appropriate programming' imposes no limitation whatever, as any general purpose computer must be programmed." Pet. App. 12a; see also *Gottschalk* v. *Benson*, 409 U.S. 63, 65 (1972) (clarifying that a "general-purpose computer is designed to perform operations under many different programs"). Thus, petitioners effectively seek to patent all gaming machines that perform the recited functions, precisely what the rule against functional claiming proscribes.

Just as this Court deemed disclosure of a "filament" as a means to perform specified functions insufficient in *General Electric*, 304 U.S. at 373, so the mere disclosure of a "computer" to perform the functions set forth in Aristocrat's patent is insufficient. If that were enough to obtain a patent, it "would extend the monopoly beyond the invention." *Id.* at 371. If petitioners had their way, no one would dare develop a gaming machine that performs the recited functions more efficiently or attractively for fear of an infringement suit. The Federal Circuit properly held that the patent laws do not permit petitioners to accomplish that purpose.

The Patent Act prevents broad functional claiming by requiring that the specification to a means-plus-function claim disclose sufficient structure to delineate the metes and bounds of the claimed invention. When the invention is a computerized device, the Federal Circuit therefore requires that the specification disclose an algorithm, that is, an indication of the steps performed by the computerized device to achieve the recited functions. That requirement en-

sures that enforceable patent monopolies cannot be achieved merely by disclosing a bare computer with "appropriate" software, which would not "clearly circumscribe what is foreclosed from future enterprise." *United Carbon*, 317 U.S. at 236. "A patent holder should know what he owns, and the public should know what he does not." *Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002).

In petitioners' view, anyone is entitled to an enforceable patent on any computerized device merely by claiming a novel function and referencing a computer in the specification. Indeed, petitioners' counsel admitted at oral argument below that such a broad impact is precisely what they seek:

> In response to a question from the court, Aristocrat's counsel contended that, in light of the breadth of the disclosure in the specification, any microprocessor, regardless of how it was programmed, would infringe claim 1 if it performed the claimed functions recited in the means-plus-function limitations of that claim. That response reveals that Aristocrat is in essence arguing for pure functional claiming as long as the function is performed by a general purpose computer. This court's cases flatly reject that position.

Pet. App. 18a-19a. Petitioners' attempt to have this Court ratify that impermissible purpose should be rejected.

B. The decision below represents nothing novel.

The decision below did not articulate any new principle of law. The Federal Circuit has consistently held that the specification of a computer-based

means-plus-function claim must disclose an algorithm to avoid invalidity for indefiniteness.

For example, in *WMS Gaming, Inc.* v. *Int'l Game Tech.*, 184 F.3d 1339, 1348-1349 (Fed. Cir. 1999), the Federal Circuit held that it is the algorithm-driven program that transforms a generic computer-based machine into a "new machine" subject to patentability. The court confirmed this "algorithm rule" in *Harris Corp.* v. *Ericsson, Inc.*, 417 F.3d 1241, 1253 (Fed. Cir. 2005), holding that, for a computer-implemented means-plus-function term, "the corresponding structure is the algorithm." The Federal Circuit has continued to apply that rule in case after case. See, *e.g.*, *Creo Prods., Inc.* v. *Presstek, Inc.*, 305 F.3d 1337, 1345 (Fed. Cir. 2002) ("a computer-implemented means-plus-function claim is limited to a computer programmed to perform the algorithm disclosed in the specification"); *Tehrani* v. *Hamilton Med., Inc.*, 331 F.3d 1355, 1361-1362 (Fed. Cir. 2003) (reversing summary judgment of infringement and remanding "to determine what algorithm forms part of the structure of the 'means for processing' limitation"); *AllVoice Computing PLC* v. *Nuance Commc'ns, Inc.*, 504 F.3d 1236, 1244 (Fed. Cir. 2007) (reversing finding of indefiniteness "for failure to set forth sufficient algorithmic structure associated with the contested means-plus-function clauses"); *Finisar Corp.* v. *DirecTV Group*, 523 F.3d 1323, 1340 (Fed. Cir. 2008), petition for cert. filed (U.S. Oct. 2, 2008) (No. 08-445) (holding that "the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶ 6"); *Net Moneyin, Inc.* v. *Verisign, Inc.*, 2008 WL 4614511, at *6 (Fed. Cir. Oct. 20, 2008) (affirming finding of indefiniteness because "specification fails to disclose an algorithm by which

a general purpose bank computer 'generat[es] an authorization indicia'"). The articles cited by petitioners for their doctrinal disarray contention either predate or fail to fully address these decisions. See Pet. 25-26.

The district courts, too, consistently have held that the specification of a computer-based means-plus-function claim must disclose an algorithm to meet the Patent Act's definiteness requirement. See, *e.g.*, *Hochstein* v. *Microsoft Corp.*, 2008 WL 4104332, at *8-10 (E.D. Mich. Sept. 2, 2008); *CBT Flint Ptnrs., LLC* v. *Return Path, Inc.*, 566 F. Supp. 2d 1363, 1372-1373 (N.D. Ga. 2008); *Alcatel USA Res. Inc.* v. *Microsoft Corp.*, 2008 U.S. Dist. LEXIS 49615, at *48-49 (E.D. Tex. June 27, 2008); *Rembrandt Tech., L.P.* v. *Comcast Corp.*, 512 F. Supp. 2d 749 (E.D. Tex. 2007); *Metrologic Instruments, Inc.* v. *Symbol Tech., Inc.*, 460 F. Supp. 2d 571, 624 (D.N.J. 2006); *Gobeli Research, Ltd.* v. *Apple Computer Inc.*, 384 F. Supp. 2d 1016, 1022-23 (E.D. Tex. 2005); *DE Tech., Inc.* v. *Dell, Inc.*, 428 F. Supp. 2d 512, 516 (W.D. Va. 2006). See also Donald S. Chisum, 5A CHISUM ON PATENTS § 18.03(5)(d)(i)(G), at 18-544.357-.360 (2007) (entitled "Computers and Software as 'Structure'—Algorithms").

Petitioners cite one district court case where the court supposedly did not require an algorithm. Pet. 28, citing *Civix-DDI, LLC* v. *Microsoft Corp.*, 84 F. Supp. 2d 1132, 1147 (D. Colo. 2000), aff'd on other grounds, 18 F. App'x 892 (Fed. Cir. 2001). In fact, the court in that case found that the specification for a claimed "means for generating a map" disclosed a public "kiosk" with "an internal electronic memory which contains signals representative of a map of the city in a region surrounding the kiosk," a data base

that "includes the coordinates for each of the subscribers," and the steps of "searching the data base of subscribers" and obtaining the coordinates for the selected subscribers. *Ibid.* Such steps amount to an algorithm requirement under the Federal Circuit's broad understanding of that term.

Petitioners also contend that the decision below conflicts with two other Federal Circuit cases. But both cases involved patents that, unlike petitioners' patent, did disclose sufficient structure. In *In re Dossel*, 115 F.3d 942, 946-947 (Fed. Cir. 1997), the specification not only included references to "known algorithms" to "solve standard equations which are known in the art," it also disclosed that the device at issue "computes, from the received data, the current distribution by mathematical operations including a matrix inversion or pseudo inversion, and then outputs the result to a display." As the Federal Circuit explained, "the *Dossel* case provides an example of an extremely detailed disclosure of all information necessary to perform the function." Pet. App. 17a.

The other case cited by petitioners, *Aristocrat Techs. Australia Pty Ltd.* v. *Multimedia Games, Inc.*, 266 F. App'x 942 (Fed. Cir. 2008), was issued by the same panel that issued the decision in this case. There is no conflict between the two cases other than the result, which was dictated by the differences between the two patents. Unlike petitioners' bare disclosure of a computerized gaming machine with "appropriate" programming in this case, the *Multimedia* specification discloses a "controller" described in detail and depicted in a figure with numerous components, including a memory, a random sequencer, a cycle register, a combination table, and a converter. *Id.* at 947. It also discloses a "pseudo-random num-

ber generating algorithm" that the panel found to be sufficient structure for the "random number selection means" set forth in the claim. *Id.* at 947-948. In short, there was sufficient disclosure of structure in the *Multimedia* specification, in stark contrast to the computer with "appropriate" programming disclosed in petitioners' specification.[1]

There is no conflict amongst these cases. The Federal Circuit consistently requires disclosure of an algorithm (broadly defined) for computer-based means-plus-function claims. The only question is whether the disclosures in the patent specification at issue fulfill that modest requirement. Some do and some do not because factual distinctions matter. Such factual distinctions are not conflicts of the type that this Court should be called on to resolve.

III. Petitioners Conflate Enablement With Disclosure Of Structure.

Petitioners contend that the Federal Circuit failed to understand that a specification need disclose only sufficient structure to enable one skilled in the art to make and use the invention. Pet. 21-23. They rely on the court's statement that "[a]lthough the examples given in the '102 patent *might enable* one of ordinary skill to make and use the invention, they do not recite the particular structure that performs the function and to which the means-plus-function claim is necessarily limited." Pet. App. 18a (emphasis added).

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[1] A recent district court case found the Federal Circuit's decisions in this case and in *Multimedia* to be fully consistent. See *SPX Corp.* v. *Bartec USA, LLC*, 557 F. Supp. 2d 810, 817 (E.D. Mich. 2008).

But that statement merely reflects the well-settled distinction between the Patent Act's general *enablement* requirement (set forth in § 112, ¶ 1) and its *structure* requirement for a means-plus-function claim (set forth in § 112, ¶ 6). In other words, the court was reiterating the established distinction between whether one skilled in the art might be able to make the function happen and whether such a person would understand the specification itself to disclose the required structure. See, *e.g.*, *Technology Licensing Corp.* v. *Videotek, Inc.*, 2008 WL 4529095, at *18 (Fed. Cir. Oct. 10, 2008); *Med. Instrumentation & Diagnostics Corp.* v. *Elekta AB*, 344 F.3d 1205, 1212 (Fed. Cir. 2003). Petitioners' view—that the mere possibility of enablement suffices to satisfy the structure disclosure requirement—confuses rudimentary principles of patent law and offers no ground for this Court's review.

CONCLUSION

The petition should be denied.

Respectfully submitted.

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NOVEMBER 2008

APPENDIX

PTO/SB/52 (04-05)
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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (optional) 19046US01

I hereby declare that:

The residence, mailing address and citizenship of the inventors are stated below

I am authorized to act on behalf of the following assignee: Aristocrat Technologies Australia Pty Limited

and the title of my position with said assignee is: ____

The entire title to the patent identified below is vested in said assignee.

Inventor: Nicholas Luke Bennett	Citizenship: Australia
Residence/Mailing Address: Manly Vale, Australia	
Inventor	Citizenship
Residence/Mailing Address	

☐ Additional inventors are named on seperately numbered sheets attached hereto.

Patent Number 6,093,102	Date of Patent Issued July 25, 2000

I believe said inventor(s) to be the original and first inventor(s) of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention entitled:

Multiline Gaming Machine

the specification of which

☒ is attached hereto.

☐ was filed on ____ as reissue application number ____ / ____.

and was amended on ____

(if applicable)

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

☒ I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b). Attached is form PTO/SB/02B (or equivalent) listing the foreign applications

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

☐ by reason of a defective specification or drawing

☒ by reason of the patentee claiming more or less than he had the right to claim in the patent.

☒ by reason of other errors.

This collection of information is required by 37 CFR 1.175. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE	Docket Number (Optional) 19046US01

At least one error upon which reissue is based is described as follows:

The means-plus-function limitations of claim 1 were determined by the Court of Appeals for the Federal Circuit to lack sufficient structure under 35 U.S.C. § 112, ¶ 6, and therefore held to be indefinite under 35 U.S.C. § 112, ¶ 2.

[Attach additional sheets, if needed.]

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.

I hereby appoint:

☒ Practitioners associated with Customer Number: 23,446

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Correspondence Address. Direct all communications about the application to:

☒ The address associated with Customer Number: 23,446

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Signature

Full name of person signing (given name, family name)
Kieran Power

Date 21/5/08

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